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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/797,617

03/09/2004

Geoffrey B. Rhoads

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4084

23735 7590 10/15/2008
DIGIMARC CORPORATION
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EXAMINER

ALLISON, ANDRAE S

ART UNIT

PAPER NUMBER

2624

MAIL DATE

DELIVERY MODE

10/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/797,617	Applicant(s) RHOADS ET AL.	
	Examiner ANDRAE S. ALLISON	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 10-11 and 15-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10, 11 and 15-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/30/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 30, 2008 has been entered. Claims 1-6, 8, 10-11 and 15-20 are pending.

Information Disclosure Statement

2. The IDS dated (09/30/2008) has been considered by the Examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. While the claims recite a series of steps or acts to be performed, a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing (Reference the May

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15, 2008 memorandum issued by Deputy Commissioner for Patent Examining Policy, John J. Love, titled "Clarification of 'Processes' under 35 U.S.C. 101"). The instant claims neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process.

Double Patenting

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 1-6, 8, 10-11 and 15-20 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 13-18, 20 and 23-24 of prior U.S. Patent No. 6,741,758.

Instant Application 10/797617	US Patent No.: 6,741,758
Claim 1	Claim 13
1. An image processing method of inputting image data with registration signals embedded therein, subjected to geometric transformation, and extracting registration signals from said inputted image data to perform registration processing, comprising: a registration signal extracting step of extracting registration signals from said image data; a frequency property determining step of determining	13. An image processing method of inputting image data with registration signals embedded therein, subjected to geometric transformation, and extracting registration signals from said inputted image data to perform registration processing, comprising: a registration signal extracting step of extracting registration signals from said image data; a frequency property determining step of

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frequency properties of said image data; a geometric transformation identifying step of identifying geometric transformation to which said image data is subjected, using said extracted registration signals and determination results of said determination in the frequency property determining step; and a geometric transforming step of performing inverse transformation of said identified geometric transformation.	determining frequency properties of said image data; a geometric transformation identifying step of identifying geometric transformation to which said image data is subjected, using said extracted registration signals and determination results of said determination in the frequency property determining step; and a geometric transforming step of performing inverse transformation of said identified geometric transformation.
Claim 2	Claim 14
The image processing method according to claim 1, further comprising: a frequency transforming step of transforming said image data into frequency components; and an inverse frequency transforming step of transforming said frequency components into spatial components	14. The image processing according to claim 13, further comprising: a frequency transforming step of transforming said image data into frequency components; and an inverse frequency transforming step of transforming said frequency components into spatial components.
Claim 3	Claim 15
8The image processing method according to claim 1, wherein in said frequency property determining step, determination is made using frequency components of said image data.	15. The image processing method according to claim 13, wherein in said frequency property determining step, determination is made using frequency components of said image data.
Claim 4	Claim 16
The image processing method according to claim 1, wherein in said frequency transforming step, Fourier transformation is performed, and conversion into amplitude spectra of said frequency components is made.	16. The image processing method according to claim 13, wherein in said frequency transforming step, Fourier transformation is performed, and conversion into amplitude spectra as said frequency components is made.
Claim 5	Claim 17
The image processing method according to claim 1, further comprising: a block dividing step of dividing said image data into at least one blocks; and a block synthesizing step of combining blocks divided by said block dividing step to reconstruct the image	The image processing method according to claim 13, further comprising: a block dividing step of dividing said image data into at least one blocks; and a block synthesizing step of combining blocks divided by said block dividing step to reconstruct the image.
Claim 6	Claim 18

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The image processing method according to claim 1, wherein said geometric transformation is scaling.	18. The image processing method according to claim 13, wherein said geometric transformation is scaling.
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Inquires

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANDRAE S. ALLISON whose telephone number is (571)270-1052. The examiner can normally be reached on Monday-Friday, 8:00 am - 5:00 pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jingge Wu can be reached on (571) 272-7429. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrae Allison

October 8, 2008

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/Jingge Wu/

Supervisory Patent Examiner, Art Unit 2624